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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,401	12/18/2001	Tomas Back	21547/0287	9654
30678	7590	08/02/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ LLP SUITE 800 1990 M STREET NW WASHINGTON, DC 20036-3425				BUMGARNER, MELBA N
ART UNIT		PAPER NUMBER		
3732				

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/020,401	BACK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Melba Bumgarner	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 May 2005.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 11-19 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 11-19 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. 09/423,090.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose that the center axes of each of the plural seats are non-parallel with each other.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the implant is intended to be positively claimed in claim 1.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 11-15 are rejected as understood, under 35 U.S.C. 102(b) as being anticipated by Emmanuel. Emmanuel discloses an elongate support element 48 comprising plural seats (page 10 line 25) penetrating a surface on the element, the element comprises a homogeneous material (page 12 line 34), a wall of each seat comprises the material, and figure 4 shown no communication between the surface on the elongate support element and an opposing surface of the element. Patentable weight is not given to inferentially claimed components. Emmanuel does not show that the seats are parallel with each other. As to claim 12, each wall has a surface in the material. The process and the intermediate products used in the process by which the element is made are not given patentable weight, because a product claim is properly met if the final product is shown regardless of the process used. As to claims 13-15, the material at the wall possesses the same material in the element having same material strength, does not have intermediate layers of material compositions and material alterations, and the same chemical composition in that the whole element is made of the same material. Emmanuel does not show material alterations other than shaping (machining) of the material.

7. Claims 11-19 are rejected as understood, under 35 U.S.C. 102(e) as being anticipated by Willoughby (5,873,721). Willoughby discloses an elongate support element comprising plural seats a surface on the element, the element comprises a homogeneous material, a wall of each seat comprises the material, and no communication between the surface on the elongate support element and an opposing surface of the element (figure 36, column 79 line 17). Patentable weight is not given to the new matter in the claims. As to claim 12, each wall has a surface in the material. The process and the intermediate products used in the process by which the

element is made are not given patentable weight, because a product claim is properly met if the final product is shown regardless of the process used. As to claims 13-15, the material at the wall possesses the same material in the element having same material strength, does not have intermediate layers of material compositions and material alterations, and the same chemical composition in that the whole element is made of the same material. Willoughby does not show material alterations other than shaping (machining) of the material. Willoughby discloses a method for producing and installing a tooth replacement structure comprising forming at least one recess directly in a blank material using milling equipment to form a support part from the blank material, the forming at least one recess avoids forming a through hole in the material, applying the support part to implants using the recess as a seat in the support part, the seat meets set accuracy of fit, and applying tooth replacement material to the support part (column 79 line 25). As to claims 17 and 18, the seat is in the formed element using milling equipment, which is fed milling coordinates information and integrated milling data. As to claim 19, the recess avoids material not integral with the blank material.

*Response to Arguments*

8. Applicant's arguments filed May 12, 2005 have been fully considered but they are not persuasive. The prior art shows the limitations as claimed. As to the indefiniteness rejection, it is the phrasing of "connecting with" that makes the claim sound as if the combination is intended to be claimed. The applicant argues that the term "no communication" in claim 11 is used to mean "without holes" (page 5 of remarks); however, where the applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so

as to put one reasonably skilled in the art on notice that the applicant intended to so redefine. In fact the word "communication" is not used in the specification. Furthermore, when in combination with the implant, communication of the surfaces is prevented. Also it is believed that the arrangement of the plural seats do not prevent the communication as implied in the claim language.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melba Bumgarner  
Primary Examiner